

### **Remarks**

Prior to this communication, claims 3-7, 10, 11, and 19-25 were pending. Claims 3-7, 10, 11, and 19-25 were rejected. By this amendment, claims 22-25 have been canceled and claims 26-34 have been added. Applicant respectfully requests reconsideration and allowance of the present application in light of the following.

### **35 U.S.C. §103 Rejections**

The Office Action rejected claims 3-7, 10-11 and 19-25 under 35 U.S.C. 103(a) as being unpatentable over Canadian Patent No. 2 334 546 (“Jackson”). Applicant has canceled claims 22-25 without prejudice to accommodate newly added claims 26-34. Applicant respectfully requests the allowance of claims 3-7, 10-11 and 19-21 in light of the following.

Claim 19 is directed to a gaming machine comprising a game controller arranged to select only one jackpot prize from a plurality of jackpot prizes as an eligible jackpot prize based on the one of the plurality of different wagers selected to be staked on the outcome of the game, and increment only the eligible jackpot prize based on the selected wager. As noted on page 3 of the Office Action, Jackson fails to teach incrementing only the eligible jackpot prize, but instead teaches that all awardable jackpots are incremented by a unique percentage.

As noted at MPEP 2141(II) and reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007), *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) sets forth the framework for determining obviousness under 35 U.S.C. 103. In particular, obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are: (i) ascertaining the scope and content of the prior art; (ii) ascertaining the differences between the claimed invention and the prior art; and (iii) resolving the level of ordinary skill in the pertinent art. The Court also noted

that objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. *Id.* at 17-18, 148 USPQ at 467. Moreover, the question of obviousness must be resolved on the basis of these factual determinations.

Applicant respectfully submits that the Examiner has failed to set forth factual findings legally sufficient to support the Examiner's conclusion of obviousness. As mentioned above, the Examiner admits that Jackson fails to teach incrementing only the eligible jackpot prize. However, the Examiner fails to provide any factual evidence to support the Examiner's contention that a gaming machine that increments only the eligible jackpot prize in the manner specified by the invention of Applicant's claim 19 would be obvious. Instead, the Examiner merely presents various conclusory statements. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

For example, the Examiner provides the following conclusory statements on page 3 of the Office Action:

- For a designer to choose to increment the other (i.e. unqualified) jackpots or not is a matter of a design choice well within the skill set of an ordinary artisan.
- However, this limitation (i.e. increment only the qualified jackpot) does not lend criticality to the invention. To choose to increment one/some/all the jackpots is strictly dependent on the design constraints that the designer is working with.

Applicant respectfully submits that the above are merely conclusory statements with no factual underpinnings. The Examiner has provided no factual evidence to support the notion that

incrementing the other jackpots or not is a matter of design choice. The Applicant does not disagree with the notion that incrementing a jackpot was within the skill set of an ordinary artisan at the time of invention. For example, Jackson teaches incrementing all awardable jackpots by a unique percentage. However, the Examiner has presented no evidence to support the notion that incrementing only the eligible jackpot was merely a design choice and not the inventive work of the Applicant.

Similarly, the Examiner has presented no evidence to support the notion that incrementing only the qualified jackpot provides no criticality to the invention. Applicant respectfully points out that the Examiner is required to consider every limitation of the claimed invention. As noted at MPEP 2143.03, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In the present case, the Examiner appears to be merely discarding the limitations of claim 19 related to a game control system arranged to "increment only the eligible jackpot prize" on the premise that such incrementing provides no criticality. In an apparent attempt to support such disregard to the limitations of claim 19, the Examiner states "To choose to increment one/some/all the jackpot is strictly dependent on the design constraints that the designer is working with." However, even this statement is not a statement of fact but instead is merely a conclusory statement. The Examiner has not provided any evidence regarding the "design constraints" that the inventor was supposedly working with, nor has the Examiner shown how such design constraints would lead one skilled in the art to increment one/some/all the jackpot. Instead the Examiner has chosen to reject the invention of claim 19 based upon a chain of unsupported conclusory statements.

In response to the Examiner's conclusory statements, the Applicant contends that

incrementing only the eligible jackpot in a gaming machine as specified in claim 19 is the inventive work of the Applicant. Moreover, Applicant contends that one skilled in the art at the time of the present invention would not find the gaming system of claim 19 obvious in light of Jackson. Applicant appreciates that both of the prior statements are unsupported conclusory statements. However, the Applicant is not required to provide evidence in support of inventiveness until the Examiner has established a prima facie case of obviousness. In other words, the burden still rests with the Examiner to provide an evidentiary basis from which a reasoned explanation of obvious may be established. Since the Examiner has yet to provide the requisite evidentiary basis and reasoned explanations, a prima facie case of obviousness has not been established in regard to the invention of claim 19. Accordingly, claim 19 is allowable over the cited art. Moreover, each of claims 3-7, 10 and 20-22 includes claim 19 as a base claim and is therefore also allowable over the cited art. Withdrawal of the present rejection of claims 3-7, 10 and 19-25 is earnestly solicited.

#### **Newly Added Claims**

The Applicant has added claims 26-34 which are allowable over the cited art for reasons similar to those mentioned above in regard to claim 19. Moreover, in order to expedite prosecution, the Applicant respectfully points out that claims 26-30 are directed to gaming systems and claims 31-34 are directed to methods in which a plurality of different monetary amounts are displayed and a player selects one the monetary amounts to be used for the wager. These monetary amounts correspond to absolute monetary wagers such as, for example, the 25¢, 50¢, \$1 and \$2 monetary amounts depicted in Figure 3 of the present application. In contrast, Jackson teaches placing a wager as a series of coin drops and does not permit a player to select a monetary amount to be used for the wager from a plurality of displayed monetary amounts.

Thus, each of claims 26-34 is further allowable over the cited art.

**Conclusion**

Applicant respectfully submits that all of claims 3-7, 10, 11, 19-22, and 26-34 are in condition for allowance and respectfully requests the allowance of such claims. In the event that the Examiner believes a telephone interview with the undersigned Applicant's Representative would be helpful in advancing prosecution of this patent application, the undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

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